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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,621	12/21/2001	Daniela Giacchetti	05725.0987-00	3961

7590 04/30/2004

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,621

Applicant(s)

GIACCHETTI ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 67 is objected to because of the following informalities: the word "and" appears to be repeated erroneously. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-55 and 67-69 are rejected under 35 U.S.C. 101 because the claimed method for providing guidance for a subject does not recite a limitation in the technological arts. The independently claimed steps of: *receiving profile information about the subject; receiving information reflecting a classification relating to birth of the subject; and providing beauty advice* are abstract ideas which can be performed mentally without interaction of a physical structure. The method steps of: *receiving profile information about the subject; and providing beauty advice* may be understood as merely obtaining an advise from a beauty consultant in a beauty salon. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-69 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The connection between “astrological horoscope sign” and “a beauty product” is not clear. The functionality connecting the method steps of: “receiving astrological horoscope sign of a consumer” and “recommending to the consumer a beauty product” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 60-62 and 64-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Maloney et al. (WO 01/18674 A2).

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

Independent Claims.

Claims 1, 36, 53, 59 and 67. Establishing a set of categories and a decision tree algorithm for classifying a consumer, the criteria including at least one of personal attribute information and lifestyle information (page 6, line 29 – page 7, line 15); advising the subject of the at least one predefined categories into which the subject is

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classified; and dispensing guidance including beauty advice, the guidance being a function of an lifestyle and age stage information of the consumer and the at least one predefined category into which the subject is classified (page 7, lines 30-31).

Claim 56. Providing a web server and a plurality of web pages relating beauty products; embedding URLs within said web pages to provide the hypertext links to other pages (page 16, line 20 – column 17, line 5).

Dependent Claims.

Claim 4. See claim 1.

Claims 5-6. See claim 1.

Claim 9-10. Prompting the consumer to provide profile information, the prompting including posing to the subject a plurality of questions seeking physical attribute information about at least one of the subject's hair, skin, eyes, and facial features (page 9, lines 4-6, 17).

Claims 11-15. See claim 1.

Claim 17. See claim 1.

Claim 18. Said method and system wherein a beauty product is selected by the consumer (page 7, line 19). Selection of the beauty product inherently indicates selection of a brand name of said beauty product.

Claims 19-20. See claim 1.

Claim 24. Said method and system, including providing a beauty advice (page 7, lines 30-31). Information as to *how to apply at least one beauty product* is not given patentable weight.) *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 404, 404 (Fed. Cir. 1983). When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.

Claim 25. See claim 1.

Claim 26. Maloney teaches said method and system, wherein the address is an e-mail address (page 6, line 32).

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Claim 27. Said method and system, wherein the information about how to purchase the beauty product includes a hyperlink to a location from which the beauty product may be ordered (page 16, lines 26-34).

Claim 29. Storing an identification code of the subject (page 17, lines 12-13).

Claim 30. Maloney teaches said method and system, wherein the guidance is further based of at least one of a demographic location of the subject and an environmental condition at a demographic location of the subject (page 17, line 33).

Claim 31. See claim 1.

Claim 32. See claim 1.

Claim 33. See claim 27.

Claim 34-35. See claim 1.

Claim 43-45. See claim 1.

Claim 46. Said method and system, wherein personal attribute information characterizes at least one of the subject's hair, skin, eyes, and facial features (page 7, line 1).

Claim 47. See claim 1.

Claim 51-52. See claim 1.

Claim 60-62 and 64-66. See claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 7-8, 16, 28, 37-42, 54-55, 57-58, 63 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Shim (US 2003/0078854).

Independent Claims.

Claim 55. Maloney teaches said method and system, comprising: receiving profile information about the consumer, the profile information reflecting at least one of physical attribute information and lifestyle information about the consumer; recommending at least one beauty product to the consumer as a function of the received profile information (page 6, line 29 – page 7, line 15).

However, Maloney does not teach receiving information reflective of an astrological horoscope sign of the subject; and recommending a beauty product to the consumer as a function of the consumer astrological horoscope sign.

Shim teaches a method and system for providing advertisement over the network, wherein consumers are classified in accordance with information including a zodiac sign, consumer's birthday and year the consumer was born [0174]; [0180]; [0194]. Said information and classification is utilized to offer the consumer beauty-related products [0052]; [0207].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include recommending a beauty product to the consumer as a function of the information including a zodiac sign, consumer's birthday and year the consumer was born consumer astrological horoscope sign, because it would enhance the effectiveness of advertising said beauty-related products, thereby increase revenue.

Dependent Claims.

Claims 2-3, 7-8, 16 and 54. See claim 55.

Claim 28. Shim teaches said method and system, wherein the address is an address of a mobile receiver/transmitter of the subject [0026].

Claims 37-38. See claim 55.

Claim 39. See claim 26.

Claims 40-42. See claim 55.

Claims 57-58. See claim 55.

Claims 63 and 68-69. See claim 55.

Dependent claims 21-23 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney and Shim.

Claims 21-23 and 48-50. Shim teaches said method and system for providing advertisement of beauty-related products over the network, wherein consumers are classified in accordance with information including a zodiac sign, consumer's birthday and year the consumer was born [0174]; [0180]; [0194]. Said information and classification is utilized for generating a prediction including suggestion of course of future events related to the consumer [0189]; [0194]; [0199]; [0202].

However, Shim does not specifically teach that said suggestion of course of future events includes a suggestion that a course of future events correlates a use of at least one specified beauty product with a predicted future occurrence.

Official notice is taken that it is well known to wear cosmetic products associated with zodiac signs to enhance possibility of occurring certain events in the future (such as for "Good luck").

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney and Shim to include that said suggestion includes correlation of use of a specified beauty product with a predicted future occurrence, because said correlation would enhance the effectiveness of advertising said beauty-related products, thereby increase revenue.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

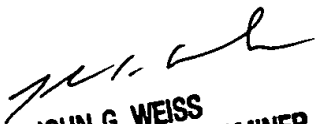
***Commissioner of Patents and Trademarks
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or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

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**JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**